

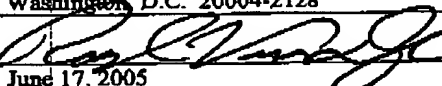
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<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>		Application Number	08/949,904
		Filing Date	October 15, 1997
		First Named Inventor	Edward R. LAVALLE
		Group Art Unit	1642
		Examiner Name	S. UNGAR
Total Number of Pages in This Submission		Attorney Docket Number	031896-05200 (GI5288B)


  

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Declaration and Power of Attorney <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Application Data Sheet <input type="checkbox"/> Request for Corrected Filing Receipt with Enclosures <input type="checkbox"/> A self-addressed prepaid postcard for acknowledging receipt <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):  <b>REPLY TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF</b>
Remarks <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 19-2380 for the above identified docket number.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	<u>Raymond Van Dyke, Reg. No. 34,746</u> Nixon Peabody LLP 401 9th Street, N.W. Suite 900 Washington, D.C. 20004-2128
Signature	
Date	June 17, 2005

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CENTRAL FAX CENTERAttorney Docket No. 31896-52000 (GI-5288B)  
Application No. 08/949,904

JUN 17 2005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Edward R. LAVALLIE *et al.*

Serial No. 08/949,904

Filed: October 15, 1997

For: HUMAN SDF-5 PROTEIN AND  
COMPOSITIONS

)

) Group Art Unit: 1642

) Examiner: Susan UNGAR

) Confirmation No.: 8744

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**CERTIFICATE OF MAILING OR TRANSMISSION**  
[37 CFR 1.8(a)]I hereby certify that this correspondence is being facsimile  
transmitted to the USPTO at \_\_\_\_\_, on June 17, 2005.Signature: Deborah MovahhediName: Deborah Movahhedi**Mail Stop Appeal Brief-Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**REPLY TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF**

In response to the Notification of Non-Compliant Appeal Brief mailed May 19, 2005,  
please consider the following remarks.

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Attorney Docket No. 31896-5200 (GI-5288B)  
Application No. 08/949,904

### Remarks

Applicants appreciate the courtesy extended by Examiner Ungar during the telephone conference with Applicants' representatives, Raymond Van Dyke and Xu Zhang on May 24, 2005. During the telephone conference, Examiner Ungar explained the basis for the Notification of Non-Compliant Appeal Brief.

In the Notification, the Examiner contends that Applicants' Appeal Brief filed February 7, 2005 does not contain the required "Grouping of claims." Applicants, however, respectfully direct the Examiner's attention to 37 CFR 41.37(c)(1)(vii), which reads:

Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

See 69 Fed. Reg. 50006 (August 12, 2004). Accordingly, Applicants respectfully submit that 37 CFR 41.37(c)(1)(vii), which became effective on September 13, 2004, does not require "Grouping of claims."

The elimination of the "Grouping of Claims" requirement is further supported by the Explanation of Changes published with the final Rules of Practice Before the Board of Patent Appeals and Interferences. See 69 Fed. Reg. 49960 (August 12, 2004). In particular, the Explanation of Changes states:

The grouping of claims requirement set forth in former Rule 192(c)(7) is removed. The general purpose served by former Rule 192(c)(7) is addressed in § 41.37(c)(1)(viii). The existing grouping of claims requirement has led to many problems . . .

See 69 Fed. Reg. 49962 (August 12, 2004). Therefore, Applicants respectfully submit that the "Grouping of Claims" requirement is no longer applicable to appeal briefs.

Applicants also respectfully submit that the Examiner's reliance on MPEP 1206 is improper. The most recent version of MPEP 1206, as revised May 2004, is based on 37 CFR

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1.192, which, however, has been removed by the final Rules of Practice Before the Board of Patent Appeals and Interferences. See 69 Fed. Reg. 49960 (August 12, 2004). Accordingly, Applicants respectfully submit that MPEP 1206, as revised May 2004, is inapplicable to the instant Appeal Brief.

Based on all of the above reasons, Applicants respectfully submit that Applicants' Appeal Brief filed February 7, 2005 complies with all of the requirements of 37 CFR 41.37(c). Reconsideration and withdrawal of the non-compliance notification are, therefore, respectfully requested.

Although Applicants believe that no fee is due, the Commissioner is hereby authorized to charge any payment deficiency to deposit account number 19-380 (31896-52000). Should the Examiner have any questions, the Examiner is invited to contact Applicants' representative designated below.

Date: June 17, 2005

Respectfully submitted,

  
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